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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/901,692	07/28/1997	AKIRA KAMAKURA	1095.1076/JD	9430
21171	7590	03/04/2004	EXAMINER KAZIMI, HANI M	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT 3624	PAPER NUMBER

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

08/901,692

Applicant(s)

KAMAKURA ET AL.

Examiner

Hani Kazimi

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2002.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1.3-12 and 14-19 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1.3-12 and 14-19 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This communication is in response to the Request for Continued Examination (RCE) and the amendment filed on September 4, 2002.

#### *Status of Claims*

2. Of the original Claims 1-10, claims 1, and 2 have been amended by Applicants' amendment filed on March 25, 1999. The same amendment has added claims 11-14. In the amendment filed on March 10, 2000, claims 2, and 13 have been canceled, and claims 1, 11, 12, and 14 have been amended. In the amendment filed on August 10, 2000, claim 3 has been amended. In the amendment filed on February 26, 2001, claim 14 has been amended. In the amendment filed on October 23, 2001, claim 1 has been amended, and claims 15, and 16 have been added. In the amendment filed on September 4, 2002, claims 1, 3, 4, 6-12, 14, and 15 have been amended, and claims 17-19 have been added. Therefore, claims 1, 3-12, and 14-19 are under prosecution in this application.

#### *Response to Applicant's Amendment*

3. Applicants' amendment and arguments filed on September 4, 2002 have been fully considered, and discussed in the next section below or within the following rejections under 35 U.S.C. § 102 and § 103 are not deemed to be persuasive, and Applicants' request for allowance is respectfully denied.

*Specification*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in the claims. The specification, as originally filed does not provide support for the invention as now claimed.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. Vas-Cat, Inc. v. Mahurkar, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'rg denied (Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

Claims 1, 3-12, and 14-19 include the limitation "a market information-registering unit registering non-binding market information that advertises a non-binding market interest of the consumer". However, the specification does not provide an enabling disclosure to support the claimed feature of "a market information registering unit registering non-binding market information that advertises a non-binding market interest of the consumer". It appears that Applicant has added the "non-binding market information" in the claims in order to overcome the Walker reference '207. However, nowhere in Applicant's disclosure is there a mention of "non-binding market information". In order for Applicant to claim what is considered to be a negative limitation, the specification has to be clear in disclosing the claimed limitation. Further

more, last paragraph, page 26 of Applicant's specification, it states, "If the consumer member determines to *accept* the pickup, a pickup 68 then takes place, --". Acceptance means binding according to Applicant's remarks paper No. 23, page 9, lines 16-20.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 3-12, and 14-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 1, 3-12, and 14-19 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification. For further examination, the Examiner interprets the claims in light of the 35 U.S.C. 112, first paragraph rejection.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the

requirements of paragraphs (1), (2), and (4) of section 371<sup>9</sup> of this title before the invention thereof by the applicant for patent.

9. Claims 15 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. US Patent No. 5,794,207 as discussed in paragraph 5 of paper No. 22.

Further, Walker teaches claimed limitation where the personal information personally identifies the consumer, and where the personal information is provided in response to the dealer being charged for the personal information (column 13, lines 1-22).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

12. Claims 1, 3-12, 14, 16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. US Patent No. 5,794,207 (hereinafter "Walker '207") in view of Walker et al. US Patent No. 5,884,270 (hereinafter "Walker '270") as discussed in paragraph 8 of paper No. 22.

Further, Walker teaches claimed limitation where the personal information personally identifies the consumer, and where the personal information is provided in response to the dealer being charged for the personal information (column 13, lines 1-22).

#### ***Response to Arguments***

13. Applicant's arguments filed September 4, 2002 have been fully considered but they are not persuasive. Applicant's arguments with respect to the non-binding market information are moot in view of the rejections above.

In the remarks, the Applicant argues in substance that;

The prior art does not teach acquiring personal information ... after the market information ... is purchased by the dealer". "The cited portions of Walker '207 do not contain any suggestion that a seller purchases anything, in particular personal information of the buyers." And nowhere does Walker discuss a basic browsing fee.

As indicated in the previously and in the present office action, Walker '207 clearly teaches the step of "acquiring personal information of the consumer necessary for the dealer to access the consumer" (column 19, lines 55-60). The fact that Walker '207 states that the communication between the buyer and seller can be anonymous is just one of the embodiments

disclosed in the Walker '207 reference. Walker '207 (column 19, lines 55-60), clearly discloses another embodiment wherein the buyer and seller can communicate with each other directly. In rejecting this feature, the Examiner cited (column 13, lines 1-53) of Walker '207 to show the data storage devices storing information pertaining to the buyer and seller including personal information, contact information, and electronic mail and URL addresses. Also, (column 19, lines 55-60) was cited for rejecting the same feature to show the direct communication between the buyer and seller. In order for the one party to communicate directly with the other party, some of the personal information disclosed in (column 13, lines 1-53) has to be known to the other party. In addition, Applicant's specification (page 10, lines 4-7,) discloses the type of personal information registered in the personal information registration section, "such as demographic information and electronic mail address" that is necessary for the dealer to access the consumer. Therefore, the cited portions of Walker '207 (column 13, lines 1-53, and column 19, lines 55-60) teaches the claimed limitation of means "for acquiring personal information of the consumer necessary for the dealer to access the consumer" as recited in claim 1."

In response to Applicant's argument that there is no suggestions in the portions cited of Walker '207 of "acquiring personal information ... after the market information ... is purchased by the dealer", and no suggestions that "a seller purchases anything, in particular personal information of the buyers."

It is unclear from Applicant's arguments in the remarks whether the dealer is purchasing the market information or the personal information. The Examiner respectfully directs Applicant's attention to the claimed limitations, (i.e. claim 1) states that "personal information registering means ..." , then "market information registering means ..." , and " ... after the market

information posted at said posting means is purchased ... ". Therefore, according to the claimed limitations what is purchased by the dealer is the market information not the personal information.

According to Applicant's specification on (page 10 , lines 12-17), " ... At this time, the corporate members select in advance the fields of their business activities, that is genres to browse, and pay a basic browsing charge for each of the selected browsing genres ...", the same page (lines 21-22) states that " ... and outputs the extracted information to the bulletin board 34.". Walker (column 13, lines 11-22), teaches the use of a web page and a bulletin board which requires a basic browsing fee.

In addition, according to Applicant's specification (pages 10-11), after the corporate member pays for the basic browsing fee and performs a search on the bulletin board for information, (page 11, lines 3-15) states that " when the corporate members pick up information on certain consumer members from the market information posted on the bulletin board 34, ...", then the pickup processing section 35 performs the following steps:

"acquires the information necessary to access these consumer members".

"causes the message processing section 36 to send an e-mail to the consumer for approval of corporate member's access if the consumer member demands his/her approval before an actual access". And

"informs the accounting section 37 of purchase of the market information ... ".

However, in analyzing the procedure of the flow chart of figure 5, and Applicant's specification (page 13, line 12 thru page 14, line 12) and in combination with figure 3, it is clear that the corporate members are able to pickup the market information based on the charge of the

basic browsing fee, and if the consumer member does not approve the corporate member's approach, then the process is ended before the charging step is performed as indicated by element (S28, of figure 5). Therefore, based on this interpretation, claims 1, 3-12, and 14-16 were rejected. Walker '207 teaches the use of a web page and a bulletin board which requires a basic browsing fee (column 13, lines 11-22). Applicant's remaining traversals are discussed within the above rejections.

***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687 or 7658.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 1114.

  
**HANI M. KAZIMI**  
**PRIMARY EXAMINER**  
Hani M. Kazimi

Art Unit 3624

December 1, 2003